

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 1-20 were present for examination. Claims 1 and 16 are amended, claims 21-24 are added, and no claims are canceled. Therefore, claims 1-24 are present for examination, and claims 1, 16, and 21 are the independent claims. No new matter is added, as the amendments are supported in the Specification (Original Application, p. 6, l. 1 - p. 7, l. 22).

The Office Action dated July 31, 2007 ("Office Action") rejected claims 1-20 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action rejected claims 1, 4, 6-8, 10-13 and 16-20 under 35 U.S.C. §102(e) as anticipated by the cited portions of Sehr, U.S. Patent 6,609,658 ("Sehr"). The Office Action rejected claims 2, 3, 14, and 15 under 35 U.S.C. §103(a) as unpatentable over Sehr. The Office Action rejected claims 8 and 9 under 35 U.S.C. §103(a) as being unpatentable over Sehr, in view of Gustin et al., U.S. Patent 5,987,439 ("Gustin"). Applicants request reconsideration in light of the amendments.

35 U.S.C. §112 Rejection

The Office Action rejected claims 1-20 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claims have been amended to address the issues raised by the Examiner, and clarify who controls the monetary values in the benefits data base.

35 U.S.C. §102(e) & §103(a) Rejection, Sehr et al.

The Office Action rejected independent claims 1 and 16 as anticipated by Sehr. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art.

However, Sehr cannot be relied upon to teach or suggest the limitations recited in amended claims 1, 16, or 21. Specifically, amended claim 1 recites a benefits provider [that is a distinct entity from the issuing authority] with the ability to access and modify the benefits data

base and the benefits monetary value therein. Nor does Sehr teach a benefits data base with access controlled by the issuing authority. Claims 16 and 21 contain similar limitations.

Claim 21 is also added to more particularly claim certain aspects of embodiments of the invention. More specifically, in claim 21, the benefits provider is an employer that confers transmit benefits to an employee patron, an element not suggested by Sehr. In addition, in claim 21 the issuing authority is a transmit authority, also an element not suggested by Sehr.

The Sehr reference sets forth a system and method that employs multi-application cards for use in the travel industry. These cards are described as having the ability to store and activate a traveler's permit for transportation and other travel services. In the *Response to Arguments* found in the Office Action, the Office appears to state that the Travel Center of Sehr teaches the issuing authority of the claims, and a Service Provider of Sehr teaches the benefits provider of the claims (Office Action, p. 3).

In Sehr, the Travel Center is, in effect, an intermediary, or broker, between passengers and transport providers. It appears to serve as a middleman for the purchase and issuance of transportation tickets (Sehr, col. 4, ll. 48-57; col. 7, ll. 28-38). It is even referred to as a remote ticket office in the Specification (*Id.*, col. 7, l. 37). However, in the claims, the issuing authority differs in functionality from the Travel Center of Sehr. The issuing authority controls access to the benefits data base, giving a benefits provider permission to modify the monetary benefits value stored for a patron. This partition of control of the benefits data base is clearly not taught in Sehr.

In Sehr, there are a number of different types of Service Providers that provide travel or financial services via the Travel Center (*Id.*, col. 4, l. 58 - col. 5, l. 7; col. 7, ll. 38-61). These Service providers are described as:

service entities that provide the transportation carriers and render various services, as well as facilitate the support functions needed for the delivery of the appropriate goods and services. The Travel/Transport Provider (32) represents the entities that provide the transport means as well as the services associated therewith. Means for transportation may include airplanes, railroads, ships, automobiles, subways, buses, or rental cars. The services may comprise travel arrangements, such as reservations or cancellations and electronic ticketing

or payments; transportation support, such as traffic management and capacity planning; and card-based marketing or sales promotions, such as loyalty and frequent traveling programs or other value-added benefits delivery schemes. The Bank/Financial Institution (33) represents the financial entity that facilitates the electronic payment process between the passenger and transport or other service providers. (*Id.*, col. 7, ll. 43-61)

This very generalized description of service providers falls far short of teaching the benefits provider of the claims. In the claims, the issuing authority grants the benefits provider permission to access the benefits storage device to input or update the benefits monetary value in the benefits data base. There is no teaching in Sehr of a benefits provider granted permission to modify the benefits monetary value in the benefits data base. Sehr does not appear to be directed at benefits providers (e.g., entities such as "government agencies, welfare agencies, educational institutions, and private businesses" that offer patron benefits).

Neither 1) the benefits provider, 2) the particular distinction between the benefits provider and the issuing authority, nor 3) the specified ability of a benefits provider to modify the benefits monetary value, is suggested by Sehr.

Moreover, in light of the above discussion of the Travel Center and Service Providers of Sehr, it is evident that elements of claim 21 are absent from Sehr. Specifically, in claim 21 the benefits provider is an employer that confers transmit benefits to an employee, and the issuing authority is a transmit authority. These and other elements of claim 21 further distinguish the teachings of Sehr from the claims.

For the reasons set forth above, it is respectfully submitted that independent claims 1, 16, and 21 are allowable for at least the foregoing reasons. Claims 2-15, 17-20, and 22-24 each depend from these independent claims and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to the claims be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (303)571-4000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael L. Drapkin". The signature is fluid and cursive, with the first name "Michael" and last name "Drapkin" clearly distinguishable.

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